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EXAMINER

PRIDY, MICHAEL B

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 03/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/811,042

Applicant(s)

AXELSON ET AL.

Examiner

Michael B Priddy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 December 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☐ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims rejected are 1-3,5,8,9,11,12,16-18,21,23,24,28,30-33,36-39,43-45,48,50-52,55,57-59,62 and 64-66.

Continuation of Disposition of Claims: Claims objected to are 4,6,7,10,13-15,19,20,22,25-27,29,34,35,40-42,46,47,49,53,54,56,60,61,63 and 67-73.

DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is too long. The Abstract should not exceed 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 72 is objected to because of the following informalities: in line 2, "plan" should be --plane--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 43-45, 48, 50-52, 55, 57-59, 62 and 64-66 rejected under 35 U.S.C. 102(b) as being anticipated by Matsen III, et al. (US 4,979,949). Matsen, III et al. teach a robot-aided system for surgery which system comprises a resection guide 215 adapted for guiding a cutting device relative to a patient's bone during arthroplasty, an alignment guide 54 coupled to said resection guide 215 and adapted for attachment to the patient's bone, said alignment guide 54 including a first assembly 152 for positioning said resection guide along a translational path and a second assembly 148

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& 142 for positioning said resection guide along a first rotational path and a second rotational path, and a computer navigation system 198 coupled to said resection guide.

Concerning the language "adapted for attachment to the patient's bone", it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. In the present case, the alignment guide 54 of Matsen, III et al. *could* be attached to a patient's bone.

Additionally, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647. In the instant case, the assemblies 142, 148, 152 and 154 could be controlled in such a way as to position the resection guide along any of three rotational paths and any of three translational paths.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 8, 9, 11, 12, 16-18, 21, 23, 24, 28, 30-33 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morawa et al. (5,788,700) in view of Matsen, III et al. (5,690,635). Morawa et al. teach an apparatus and method for the alignment of a total knee prosthesis which includes a clamp 60 for anchoring the system to the distal tibia, a resection guide 90 which is attached to the clamp 60 via an alignment assembly 70. Resection guide includes sockets in its proximal surface for receipt of connecting elements for the attachment of other instruments such as stylus assembly 120 or a computer navigation system. Assembly 70 includes an upper shaft portion 40 telescopically received in lower tubular member 46 which allows for proximal-distal movement of the resection guide 90 with respect to the anchoring clamp 60. A first carriage 72 allows for anterior-posterior sliding movement along a first guideway 74 which is carried by a second carriage 76 allowing for medial-lateral sliding movement along a second guideway 78. The apparatus further includes an extra-medullary alignment rod 20 which may be removably connected to the resection guide via slot 150 of block 142.

Concerning the limitations of claims 5 and 31 referring to the anchoring means, Applicant's attention is drawn to US Patent No. 5,704,941 which issued from application 08/552594 as mentioned in line 3 of column 5 of Morawa et al. The disclosure of '941 is incorporated by reference and includes a description drawn to the clamp 60 of Morawa et al. but referenced as 70 in '941. The clamp includes two angled bodies 76 as shown in Fig. 6 and also includes a side slot as seen in Figs. 1 and 4. Hence Morawa et al.

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teach all of the limitations of the present invention except that the apparatus includes a computer navigation system.

Matsen, III et al. teaches a prosthesis template for use in a robot-aided system for surgery. A saw guide 215 is attached to a coupler 160 which attaches various tools to robot wrist 154. The robot 54 is controlled by a controller 55 which directly controls and monitors the movement of the robot. A supervisor 56 in the form of a personal computer 66 supervises the communications between the robot 54 and the controller 55. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have incorporated the robotic navigation system of Matsen, III et al. with the apparatus of Morawa et al. in order to ensure perfect or near perfect alterations are routinely achieved to thereby avoid poor knee mechanics and/or loosening of prosthetic components due to imperfect fit as a result of imperfect resection.

Allowable Subject Matter

Claims 4, 6, 7, 10, 13-15, 19, 20, 22, 25-27, 29, 34, 35, 40-42, 46, 47, 49, 53, 54, 56, 60, 61, 63, 67-71 and 73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 72 is objected to as set forth above, but would be allowable if rewritten to overcome the objections to minor informalities

Response to Arguments

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Applicant has argued that the means-plus-function language of the independent claims 1, 16 and 31 must not be disregarded and refers the Examiner to the Federal Circuit decision *In re Donaldson Company, Inc.*, 16 F.3d 1189 (Fed. Cir. 1994) *en banc*. It is the Examiner's understanding that Applicant's intention is to invoke 35 USC 112, sixth paragraph. However, the means-plus-function language of claims 1, 16 and 28 fails to meet the conditions of the 3rd prong of the 3-prong analysis in that the phrase "means for locating the resection guide relative to the anchoring means" preceded by the modifying structural language "alignment". If the phrase "means for" is modified by sufficient structure, material or acts for achieving the specified function, the USPTO will not apply 35 U.S.C. 112 sixth paragraph until such modifying language is deleted from the claim limitation. In the instant case, the "means for" language is preceded by "alignment" and further modified by "said alignment means providing three degrees of freedom." The Examiner has therefore maintained the rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

Michael B. Priddy

March 12, 2003

Kevin Shaver
KEVIN SHAVER 3/12/03
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